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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,718	07/29/2004	John Crawford	JRC.US.1	4717
24111 7590 11/22/2005 MESMER & DELEAULT, PLLC 1 NEW HAMPSHIRE AVE. SUITE 125 PORTSMOUTH, NH 03801			EXAMINER KLEIN, GABRIEL J	
			ART UNIT 3641	PAPER NUMBER
DATE MAILED: 11/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/710,718		CRAWFORD, JOHN	
	Examiner		Art Unit	
	Gabriel J. Klein		3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 8-10 are objected to because of the following informalities:

a) In claim 8, line 2 it states: "...in the hinge mechanism so prevent movement past..." It is suggested that the language be changed to read: "...in the hinge mechanism so **as to** prevent movement past..."

b) In claim 9, line 2 it states: "...in the C-shape so prevent movement past..." It is suggested that the language be changed to read: "...in the C-shape so **as to** prevent movement past..."

c) In claim 10, line 2 it states: "...in the forearm brace member so prevent movement past..." It is suggested that the language be changed to read: "...in the forearm brace member so **as to** prevent movement past..."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "standard" in the last sentence of the claim is indefinite. One of ordinary skill in the art would not know what a "standard rifle butt" is because there is no such "standard." Rifle butts come in many different shapes and sizes, but none of them are considered "standard" to those skilled in the art.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the hinge mechanism" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. The examiner will consider the claim with the following portion omitted from line 2: "in the hinge mechanism."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-10, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hentzi (3260489).

In reference to claim 1, Hentzi discloses a forearm support brace comprising a C-shaped attachment member (figures 1 and 2, element B (hook B)) having a forearm brace member (figure 1, the rightmost three-quarters of hook A) secured at a forearm brace proximal end, defined as where the labels 10a and 10b are approximately pointing (figure 1), substantially perpendicular to the C-shape attachment.

It should be appreciated that the device of Hentzi is capable of meeting the functional use recitations set forth in the claims. These include: attachment to a rifle butt, facilitation of one-handed firing capability, and the allowance of ambidextrous use.

The a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

In reference to claim 3, Hentzi discloses that said C-shape is made of a formed bar (column 1, lines 53 and 54) having two substantially parallel ends joined by a semi-circular section (figure 1). Inherently said C-shape has size and is therefore sized in relation to other objects (such as rifle butts). It should be appreciated that the device of Hentzi is capable of the functional use recitation set forth in the claim in that said C-shape is capable of conforming to the cross-section of a rifle butt.

In reference to claim 6, Hentzi discloses a forearm support brace wherein the length of the forearm brace member is substantially the same as the width of a human forearm. It should be appreciated that the human forearm ranges in size greatly from person to person. The human forearm could be anywhere in width from about 1 inch (infant) to 8 inches (extremely obese). Hentzi implicitly states in column 2, lines 20-25, that said forearm support brace takes on different sizes relative to the size of the rail said brace hangs on. In the example given, hook B of figure 1 is said to have a spacing of $\frac{3}{4}$ inch. Referring to figure 1 it is apparent that the rightmost three quarters of hook A is at least greater than 1 inch.

In reference to claim 7, Hentzi discloses a forearm brace member ending in a boss. According to www.dictionary.com, a boss is defined as a protuberance. It is clearly seen in figure 1 that the rightmost end of the forearm brace member inherently comprises a protuberance. Due to the upward extension of said protuberance, it is clear that said boss is capable of the functional use recitation set forth in the claim in that said boss is capable of preventing a users forearm from sliding beyond.

In reference to claims 8-10, Hentzi discloses a stop, defined as the solid junction between said C-shape and said forearm brace member. Said stop is capable of meeting the functional use recitation as set forth in the claim in that said stop is a rigid connection between said C-shape and said forearm brace member. It should be appreciated that said stop is inherently formed in both said C-shape and said forearm brace member.

In reference to claim 16, Hentzi discloses a forearm brace member that is curvilinear (figure 1, the rightmost three-quarters of hook A).

Claims 1-3, 5-10, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tritt (2295370).

In reference to claim 1, Tritt discloses a forearm support brace comprising a C-shaped attachment member (figure 4, element 20) having a forearm brace member (figure 4, element 17) secured at a forearm brace proximal end substantially perpendicular to the C-shape attachment.

It should be appreciated that the device of Tritt is capable of meeting the functional use recitations set forth in the claims. These include: attachment to a rifle butt, facilitation of one-handed firing capability, and the allowance of ambidextrous use.

The a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

In reference to claim 2, Tritt disclose a forearm support brace comprising a hinge mechanism joining the C-shape and the elongated forearm brace member (figure 6).

In reference to claim 3, Tritt discloses that said C-shape is made of a formed bar (page 1, column 2, line 3) having two substantially parallel ends joined by a semi-circular section (figure 4). Inherently said C-shape has size and is therefore sized in relation to other objects (such as rifle butts). It should be appreciated that the device of Tritt is capable of the functional use recitation set forth in the claim in that said C-shape is capable of conforming to the cross-section of a rifle butt.

In reference to claim 5, Tritt discloses that said forearm support brace comprises a foam rubber lining material applied to a surface inside the C-shape (figure 3, element 26 and page 1, column 1, line 33).

In reference to claim 6, Tritt discloses a forearm support brace wherein the length of the forearm brace member is substantially the same as the width of a human forearm. It should be appreciated that the human forearm ranges in size greatly from person to person. The human forearm could be anywhere in width from about 1 inch (infant) to 8 inches (extremely obese). Although Tritt remains silent to the length of the forearm brace member in the specification, figure 1 shows the length of said forearm

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brace member relative to the depth of a hat. It is apparent from this figure that the forearm brace member of Tritt is wide enough to accommodate a human forearm.

In reference to claims 7 and 15, Tritt discloses a forearm brace member ending in a boss. According to www.dictionary.com, a boss is defined as a protuberance. It is clearly seen in figure 4 that the right side of element 17 inherently comprises a protuberance. Due to the upward extension of said protuberance, it is clear that said boss is capable of the functional use recitation set forth in the claim in that said boss is capable of preventing a users forearm from sliding beyond.

In reference to claims 8-10, Tritt discloses a stop (figure 6, element 31) between said C-shape and said forearm brace member. Said stop is capable of meeting the functional use recitation as set forth in the claim in that said stop is a rigid connection between said C-shape and said forearm brace member. It should be appreciated that said stop is inherently formed in both said C-shape and said forearm brace member since said stop requires one surface of each to function.

In reference to claim 14, Tritt discloses that said forearm brace member is elongated and substantially straight (figure 4, element 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tritt in view of *In re Boesch*. Tritt discloses the claimed invention except for the width of said formed bar being **a)** at least a half-inch wide, or **b)** about 0.75 inches wide. Tritt also does not disclose the thickness of said bar as being about 0.125 inches thick. It would have been obvious to one having ordinary skill in the art at the time the invention was made to dimension said bar with a width of **a)** at least a half-inch wide, or **b)** about 0.75 inches wide, and with a thickness of about 0.125 inches thick, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tritt in view of *In re Leshin*. Tritt discloses the claimed invention except for said brace being made of at least one material taken from the group consisting of aluminum, steel, stainless steel, heavy plastic, and fiber-glass. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make said brace of at least one material taken from the group consisting of ^{any well known materials such as} aluminum, steel, stainless steel, heavy plastic, and fiber-glass, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

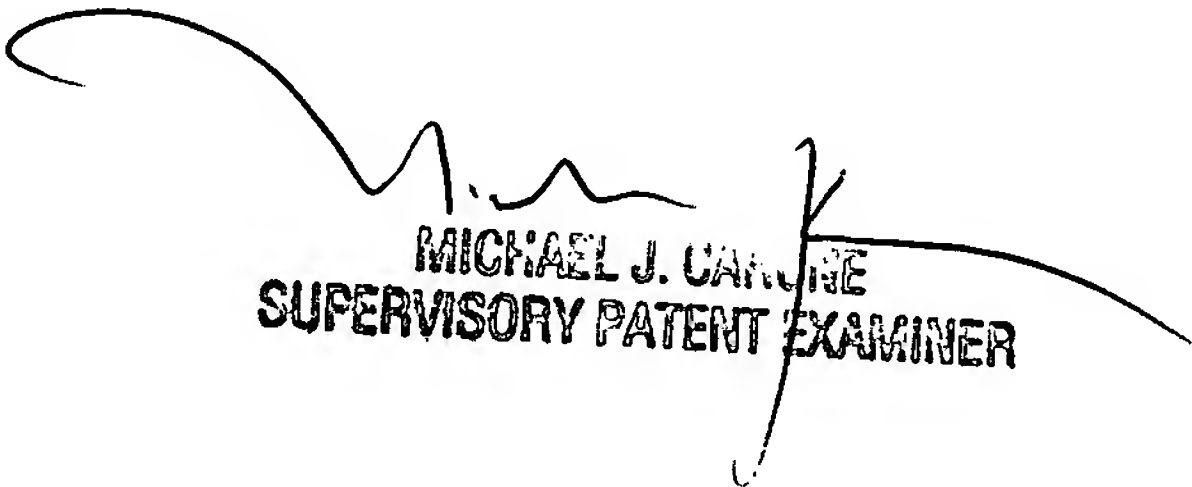
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gipson (4248399) discloses a forearm support brace comprising a hinged forearm brace member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel J. Klein whose telephone number is 571-272-8229. The examiner can normally be reached on Monday through Friday 7:15 am to 3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GJK



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER